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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

SETRAK K. BOYAJIAN, individually
and doing business as
PRECISION TESTING LABORATORIES,
Petitioner,

vs.

OLD COLONY ENVELOPE CO., INC.
and STEIN HALL & CO., INC.
Respondents.

PETITION FOR A WRIT OF CERTIORARY TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

SETRAK K. BOYAJIAN,
Petitioner,

P. O. Box 973,
Worcester 1, Massachusetts.

KENDRICK PRINTING CO., WESTBORO, MASS.

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In The

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No.

SETRAK K. BOYAJIAN, individually
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OLD COLONY ENVELOPE CO., INC.
and STEIN HALL & CO., INC.,
Respondents.

PETITION FOR A WRIT OF CERTIORARY TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit, entered in cause No. 6129 therein on November 5, 1963. (Appendix A)

OPINIONS BELOW

The opinion of the Court of Appeals (infra, Appendix B) was entered on November 5, 1963. (Your petitioner is not aware if it is reported.)

The original and supplemental memorandum-opinions of the District Court were entered on February 5 and 13, 1963, respectively, and have been printed on pages 79-82 and 84-86 of the Record Appendix to Brief for Appellant, printed for use in the court below, the original and nine copies of which have been filed with this petition, and marked (R) for reference. (Your petitioner is not aware if said memorandum-opinions are reported.)

The record accompanying this petition consists of:

The original (certified) and nine copies of the Record Appendix to Brief for Appellant, printed for use in the Court of Appeals in cause No. 6120, marked with a large (R) for reference herein.

The original (certified) and nine copies of the Record Appendix to Brief for Appellant, printed for use in the Court of Appeals in cause No. 5598 and incorporated on appellant's motion (R. 101) by reference into (R) above, and marked with a large (RA) for reference herein.

The original (certified) and nine copies (printed) of Appellant's Petition for Rehearing seasonably filed in the Court of Appeals, and marked with a large (RH) for reference herein.

Herewith are also filed:

I.

The original (certified) and nine copies of each of "Appellees' Appendix to Brief", printed for use in the Court of Appeals in cause No. 6120, and of "Record Appendix to Brief for Appellee", printed for use in the Court of Appeals in cause No. 5598, so incorporated by reference, and marked with a large (X) and (Y) respectively for reference herein.

Your petitioner intends to present questions on the merits for review based only on matter printed [illegible]R), (RA), and (RH).

"Appellees' Appendix to Brief." (X) is a massive surplussage. For reasons of its own, the Court of Appeals has seen fit to allow, despite strong opposition by Appellant, the unprecedented (for a summary judgment proceeding) sum of $2,326.00 for its cost of printing. This represents a wide departure from the accepted and usual course of judicial proceedings as relates to the taxation of costs.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

The Constitution of the United States:

Article I, Section 8.

"The Congress shall have Power . . .

"To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;".

Fifth Amendment:

"No person shall * * * *, nor be deprived of * * * property, without due process of law;".

Seventh Amendment:

"In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, * * * *."

28 U.S.C. 2072.

Rule 56, Rules of Civil Procedure for the United States District Courts.

35 U.S.C. 112 (First Paragraph):

"* * * * to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

(Third paragraph).

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof".

35 U.S.C. 261.

"* * * * *, patents shall have the attributes of personal property."

35 U.S.C. 271.

"A patentee shall have remedy by civil action for infringement of his patent."

JURISDICTION

The judgment of the Court of Appeals was entered on November 5, 1963 (*infra*, Appendix A). A timely petition for rehearing was denied on November 26, 1963, (Appendix C), (RH). The jurisdiction of this Court is invoked under the provisions of 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether, admitting that an additional element is necessary to render the device in a claim operative, does it necessarily follow that the omission of such element invalidates the claim, or that the precise element described in the patent as rendering it operative must be read into the claim?

2. Whether it is not the well established rule of patent claim construction that a broad claim will not be construed to contain limitations expressed in more narrow claims?

3. Whether the doctrine of equivalents is applicable where the accused device performs substantially the same function in substantially the same way to obtain the same results as that claimed for the patented device?

4. Whether a claim limits a patentee to the exact mecha-

* Your petitioner is conscious of the fact that a greater number of questions has been presented herein than it is customary. This was in part necessitated by the fact that, for reasons of its own, the Court of Appeals has seen fit to give its blanket sanction (Appendix B) to District Court's memorandum decision of February 5, 1963 (R. 79-82), without any opinion of its own, which if given would have inevitably required the presentation of fewer questions. As it is, questions herein presented involve vital issues, and their consideration, singly or in categories, by the Court is respectfully prayed for; except such question, if any, which the Court may consider unnecessary for granting the certiorari.

nism described, leaving the infringers at liberty to construct substantially identical copies of the patented device by varying in form, degree, or proportion of any element therein, or to adopt chemical, mechanical, or method equivalents for the production of the patented device, or portions thereof?

5. Whether it is the sense of Patent Law that one may escape infringement by heating the accused product "to a temperature *deliberately* kept several degrees lower than 212°" (emphasis added), where there is no temperature limitation in the patent in suit, or even where there is such limitation?

6. Whether the law of infringement can be evaded by a variation in method or process of production when the patentable idea covers a physical structure?

7. Whether a product patent is infringed, if the product complained of is the patented article substantially as described, regardless of by what path or process, old or new, inferior or improved, the infringing product is manufactured?

8. Whether, assuming (arguendo) that the boiling step substantially as described in the specification constituted a limitation in 1952 when the invention was reduced to practice, did it still constitute such a limitation in 1959 when Stein Hall depositions were taken, where during the intervening years after the patented article was placed on the market in early 1953 "a tremendous amount of researching" had been undertaken, by virtue of the patent in suit, by those skilled in the art, to improve the properties of polyvinyl alcohol for use as an essential ingredient in the accused article?

9. Where the expressed purpose of the boiling is to distill off the volatile contaminants and not the water, whether the temperature of the boiling is governed by the vapor pressure of the contaminants, or by that of the water?

10. Whether under Rule 56 the District Court was permitted to act as its own scientific expert by injecting its own concept of what scientific definition of boiling is, concluding that the word "boiled . . . is not a lay term of flexible meaning," and thereby making a finding of fact, without a trial, that "the only possible inference is that in the Stein Hall process the polyvinyl alcohol is NOT boiled"?

11. Whether the moving party in a summary judgment proceeding is entitled to the benefit of favorable inference to be drawn from his papers, or whether matters presented in connection with the motion must be construed most favorably to the party opposing the motion, and regardless of whether or not the non-moving party has submitted affidavits or other material, the burden is on the moving party to establish that there is no genuine issue as to any material fact and that he is entitled to summary judgment as a matter of law, and that the court is powerless to shift that burden?

12. Whether on a motion for summary judgment the court can try issues of fact, giving or withholding credence to or from either party, characterizing affidavits of the one as "observed facts" and affidavits of the other as "sworn arguments"?

13. Admitting that affidavits may be used in a motion for summary judgment, whether the court may resolve disputed fact issues by reference to the affidavits?

14. Whether Rule 56 of Rules of Civil procedure for the United States District Courts was intended to nullify, repeal, amend, or modify the Due Process and Right of Trial by Jury Clauses of the Constitution of the United States by providing the use of the summary judgment procedure as a convenient substitute for trial by jury, where a trial by jury of all issues triable as of right by a jury has been seasonably demanded in defendant's counterclaim and insisted upon by him during the proceedings of the case, and where pleadings, depositions, and affidavits filed by both parties show the existence of genuine issues as to material facts, and where defendant's repeated motions to frame issues for the jury have been denied or ignored by the District Court?

15. Whether it is the purpose of summary judgment procedure to cut off a litigant, by permitting a finding of fact against him, from his right of trial by jury, where he really has evidence which he will present at the trial, and where he so states under oath.

16. Where facts are peculiarly within the knowledge, and so proof is largely in the hands, of the moving party, whether the non-moving party is not entitled to a trial on the merits to afford him the opportunity to have the opposing witnesses face the court and the jury, and be examined and cross-examined under the rules of evidence, and be discredited and secure admissions from them, and whether a case that can be made out in all its elements by cross-examining such opposing witnesses is not a strong case?

17. Whether it is the sense of patent law in the light of summary judgment procedure that one may escape infringement, and even a trial, by making an affidavit that he

is not infringing, where the facts are solely known to himself and to his own witnesses, and the truth can only be established by cross examining him and his witnesses under the rules of evidence, during a trial on the merits?

18. Whether the very same grounds, references, and circumstances that saved the patent in suit on the issues of validity in an earlier appeal could lawfully defeat the same patent on the issues of infringement in a subsequent appeal, where there were no other grounds, references, or circumstances to justify such defeat?

19. Whether a patent for a very useful and meritorious discovery and development which has greatly advanced the art is not entitled to a liberal construction and to a wide range of equivalents?

20. Where a great demand for the patented product had existed, and where the accused product was not placed in the market until after the accused infringers had seen and spied upon the patented product, whether they (accused infringers) can escape infringement simply by making an affidavit that they are not boiling, and whether such an affidavit could lawfully support a finding, by "inference", that the accused product "is NOT boiled, for it never reached the temperature of 212 F. . . . ?"

21. Whether one can escape patent infringement by a colorable departure in method with no substantial or effective difference?

22. Whether the scope of a patent is the prisoner of verbalism, or whether certainty required in patents is no greater than that which is reasonable to secure effective protection against infringement and that one may not

escape infringement by claiming that he is only "cook"ing, and not "boil"ing?

23. In the face of the Court of Appeal's earlier ruling in this case (R. 20) that whether the DuPont "brochure disclosed information on technique or characteristics that make boiling obvious to solve the problem met by defendant still remains", whether plaintiffs are in any position to claim that they are not infringing because they are only using such information?

24. In the face of the Court of Appeal's earlier ruling in this case (R. 20) that the fact that "there was no use of polyvinyl alcohol as a sealing gum for envelopes prior to the introduction of defendant's product in 1953 would seem to be circumstantial support for a conclusion that there was an additional obstacle to the use of polyvinyl alcohol as an envelope sealing gum beyond the mere breaking down of lumps in aqueous solution", whether plaintiffs are in any position to claim that they are not infringing because all they do is to dissolve polyvinyl alcohol in water, without giving the reason why, in view of the known great demand for the product, they did not do so before defendant's invention?

25. In the face of the Court of Appeal's earlier ruling in this case (R. 18) that the "disclosure that a particular treatment had been made to the solutions, without spelling out the purpose of that treatment, or the effect in regard to an important characteristic for a particular use, i.e. envelope seal, does not seem to us to invalidate any invention by one who uses the treatment to achieve the result of overcoming a particular problem", whether plaintiffs are in any position to claim, *after the purpose of such treatment had been spelled out to them by defendant's invention*, that

they are not infringing because they are using the earlier treatment to achieve the results disclosed and claimed in defendant's patent.

26. Whether from the evidence presented by plaintiffs by their "cooking process" during the deposition of John Mahlmann (R. 91-99), in view of the evidence presented by Defendant's Affidavit in Support of his Opposition to Plaintiffs' Motion for an Order to Show Cause (R. 25-33), could not the jury find, in a trial on the merits, that plaintiffs are following in their said cooking process the teachings of defendant's patent substantially as disclosed and claimed therein?

27. Where defendant has in his counterclaim (RA. 29) charged Stein Hall with "infringing said patent by manufacturing and selling the adhesive composition disclosed therein to the plaintiff Old Colony Envelope Company, Inc. *and to others*, wilfully urging them to use the same for manufacture of the accused articles", whether an affidavit that "I can, and do, say categorically that no polyvinyl alcohol of any Superseal adhesive ever sold by Stein Hall to Old Colony was ever boiled" could lawfully support the dismissal of said counterclaim as to such *others*?

28. Where plaintiffs have alleged in their petition for declaratory judgment (RA. 8) that

> "An actual controversy has arisen and exists between Plaintiff and Defendants as to the alleged infringement by Plaintiff of said Letters Patent and as to the validity of said Letters Patent.",

whether the District Court could properly grant summary judgment to plaintiffs on the ground that there are no genuine issues as to material facts, the face of such allegation in the plaintiffs' said petition.

STATEMENT OF THE CASE

Your petitioner seeks to review by certiorari the judgment of the United States Court of Appeals for the First Circuit (Appendix A) affirming the Amended Judgment of the United States District Court for the District of Massachusetts (R. 82), entered on January 6, 1963, declaring that plaintiffs have not infringed Claims 1, 2, 3, 4, 6, 7, 8 and 9 of the patent in suit, and dismissing defendant's counterclaims "with prejudice".

The action in the District Court arose under the Patent Laws of the United States. It was commenced back on December 30, 1957, by plaintiffs by a petition for declaratory judgment (R.A. 7) pursuant to Sections 2201 and 2202 of Title 28 United States Code, alleging invalidity and non-infringement, admitting the use of polyvinyl alcohol in producing the accused envelopes, and asserting the existence of an "actual controversy" as to both validity and infringement (R.A. 8). Jurisdiction and venue of the District Court were invoked under and predicated upon Sections 1338(a) and 1391(b) of Title 28 United States Code.

There is no allegation in said petition, or in any of the pleadings subsequently filed in the case by plaintiffs, that the accused device does not do substantially the same work in substantially the same way to accomplish the same results. Actually, substantial identity between them has been and is being claimed by the accused infringers (R.A. 15-19, 21, 50-51). The answer (R.A. 11-12) contains a denial of all adverse allegations in said petition, and a counterclaim alleging infringement, seeking damages, and demanding a trial by jury of all issues triable as of right by jury (R.A. 12).

The patent in suit, namely, U.S. Patent 2,804,395 (RA. 97-101), was issued on August 27, 1957 (on application filed on September 4, 1953) to, and is still owned by, your petitioner, and is entitled "Envelopes and the Like with Remoistenable Adhesive Comprising Polyvinyl Alcohol". Briefly, the subject matter of the invention is primarily an envelope (with adhesive therefor) having an improved seal flap, with half the claims and nearly all of the specification directed to it; the rest being for improved gumming for paper, postage stamp, label, and tape. Eleven objectives embodying the principal features of the invention are set forth in columns 1 and 2 of said specification (RA. 99). *The fact of the realization of these objectives has not been denied or in any way challenged by plaintiffs. The invention itself has been proclaimed by the envelope industry and by the accused infringers as a revolutionary development of great magnitude, and its reception by said industry was nothing short of the phenomenal* (RA. 44-52).

After a series of prolonged "discovery" procedures by plaintiffs, the case came up for hearing, on September 14, 1959, on plaintiffs' motion for summary judgment alleging invalidity and non-infringement. Two days later, namely, on September 16, 1959, the District Court entered its decree (RA. 68-69) granting plaintiffs' motion as to validity by declaring all claims of the patent in suit invalid, and dismissing defendant's counter-claims "with prejudice", and further providing:

> "2. All other relief sought in the complaint depending on issues of infringement, and such issues of infringement not now being determined by this Court, and such issues having become moot inasmuch as the patent has been adjudged invalid, such other relief is denied "without prejudice". If, on appeal, the first

paragraph of this decree be reversed, modified, or vacated, then automatically this paragraph shall be of no force and effect, and the denial hereby provided shall be set aside."

The District Court's opinion (R.A. 63-68), accompanying the said decree, is reported in *Old Colony Envelope Co., Inc. Et Al. v. Setrak K. Bonajian*, 176 F.Supp. 627.

Your petitioner herein (defendant in the District Court case) appealed (R.A. 69) to the United States Court of Appeals for the First Circuit. Thereupon, namely, on June 14, 1960, the Court of Appeals entered its Judgment reversing the decision of the District Court and vacating its Decree. The whole Decree, including the above-quoted second paragraph, and not just the "first paragraph", was vacated. Mandate was accordingly entered on June 30, 1960 (R.). A certified copy of the OPINION OF THE COURT (of Appeals) (R. 15-21) accompanied the Mandate. It is reported in *Setrak K. Bonajian, etc. v. Old Colony Envelope Co., Inc., Et Al.*, 279 F2d. 572. It is also printed in the Record Appendix to Brief for Appellant, on pages 15 to 21 (R. 15-21).

Thereafter, namely, on July 20, 1960 plaintiffs gave notice of filing a motion "to show cause" why summary judgment in their favor should not be entered on issue of infringement (R. 23), presumably by virtue of said second paragraph of the District Court's vacated Decree (R.A. 68). Long thereafter, after numerous dilatory tactics on their part, plaintiffs filed, as of September 19, 1962, their motion for summary judgment (R. 40) on the issue of infringement. That motion came up for hearing on February 4, 1963 (R. 32-79). On February 6, 1963, the District Court entered its Amended Judgment appealed from (R. 82-83,

88). The District Court rendered its decision by its memorandum of February 5, 1963 (R. 79-82), supplemented by its memorandum of February 13, 1963 (R. 84-86).

A brief history of the case, as a part of the Statement, shows the following: Your petitioner has since 1920 been engaged in the research and development of adhesives, at substantial periods of time with particular interest in envelope adhesives. A world-wide chronic problem in envelope seal gum had existed from beginning of the envelope industry. Your petitioner's interest in polyvinyl as a possible means for the solution of that problem was aroused before the possibilities of that material were commercially known or understood and when it was but little more than a laboratory curiosity. Some twenty years later, namely, in 1952, he had produced several workable samples of envelope seal gum having polyvinyl alcohol as an essential ingredient therein, and on or about September 24 of that year a test run was made in an envelope plant (RA. 54), and on or about February, 1953, regular operations of producing the patented envelopes were started, (RA. 41, 55, 57).

Briefly, the principal problem was to obatin a concentrated solution of polyvinyl alcohol that would remain permanently colorless and free-flowing on standing, and its film permanently remoisteniable after being deposited, with or without compatible additions, on an envelope seal-flap and dried under elevated temperatures in a conventional envelope machine. Your petitioner found that these properties were conditioned upon the substantial purity, freedom from all volatile contaminants, and homogeniety throughout of the polyvinyl alcohol. He used the expedient of boiling as the best mode contemplated by him of carrying

out his invention at the time it was reduced to practice (35 U.S.C. 113, first par.). (Ra. 69-72, 87-88, 99-101).

When such operations were well underway, defendant sent samples of the envelopes so made to the envelope industry, Old Colony included, and its reception was phenomenal and more than sixty envelope manufacturers, including said Old Colony, responded enthusiastically (RA. 44). Many commented by letter as follows:

> "Our purpose of contacting you originally was a feeling that your new Phantom-Seal gum has a great deal of merit and we do want to give it a thorough test in both plants." (RA. 47)
>
> "Carpenter Paper Company owns and operates six envelope plant subsidiaries and therefore we are very much interested in this development." (RA. 47)
>
> "We have been receiving your samples of Phantom-Seal Gum (envelopes) and are naturally impressed with its quality." (RA. 47)
>
> ". . . as he felt sure that it (PHANTOM-SEAL) would produce a superior seal and, as you know, this has been somewhat of a problem in gluing rag content papers." (RA. 48)
>
> "We think you have something (PHANTOM-SEAL) here which may prove very important to the envelope industry." (RA. 48)
>
> "We are very much interested in the results you obtain in your Phantom-Seal by quick penetration of the paper fibers when sealing the samples that you sent

on Phantom-Seal envelope gum." (RA. 48)

These and other comments like them, including the names of the envelope manufacturers who sent them are listed in Part 1, defendant's affidavit (RA. 41, 44-45). See also (RA. 54-64) for the affidavits of experts in the envelope industry. Affidavit of Eldon Pond (RA. 55) shows that he took samples of PHANTOM SEAL envelopes with him to the annual meeting of Envelope Manufacturers Association of America in November, 1953 in Chicago, and great interest was shown therein by other envelope manufacturers, including the technical expert of Old Colony; and that while he was in Chicago an envelope manufacturer approached him and solicited his "cooperation" in the interest of his own adhesive supplier. Affidavit of Ralph Waterhouse (RA. 57) shows that in said November, 1953 two Stein Hall employees tried to gain access to the plant of Worcester Envelope Company by subterfuge, for the purpose of spying on PHANTOM SEAL. Affidavit of Fred Fromm (RA. 58) shows that he saw the salesman or official of a large New York adhesive manufacturer secretly obtain a sample quantity of Phantom-Seal and carry it away with him in or about August of said 1953 from the plant of Berlin & Jones Co., in New York. By a special MEMORANDUM (RA. 59), duly attested to, Pitney-Bowes described the properties of the PHANTOM SEAL and gave its servicemen instructions to adjust their sealing machines to suit the new Seal flaps. Affidavit of John W. Lund (RA. 54) shows the impression PHANTOM SEAL had made on adhesive suppliers, and their frantic activity toward efforts to imitate it. All further show, among other things, the stark newness of PHANTOM SEAL. These affiants were all highly skilled and experienced men in the envelope industry, and they all vouched that they had never seen or known anything like it before.

Old Colony was one of the first to respond (RA. 15, 21). It sent, as many others did, blocks of difficult envelope paper, which defendant had subsequently cut and folded into PHANTOM-SEAL ENVELOPES and returned to the respective senders. There was considerable correspondence with Old Colony during the second half of 1953 and the early part of 1954. As late as February 15, 1954 the president of Old Colony wrote: "We already know that it (PHANTOM-SEAL) will give satisfactory adhesion to our papers (RA. 15).

Old Colony started manufacturing the accused envelopes in the summer of 1954, and it announced this fact by means of two bulletins (RA. 15), dated June and July, respectively, of that year. In the first of said bulletins it described the "New Adhesive for Rag Bond Envelopes" as ". . . a revolutionary front seal gum . . ." and in the second as "A truly amazing development in adhesives." Another envelope manufacturer, namely, Boston Envelope Company, issued a one-page bulletin in November, 1954, reading in part as follows: "IT MAKES YEARS OF VEGETABLE GUM RESEARCH—OBSOLETE!" "Here is a sample showing the latest development in the manufacture of envelope seal-flap gumming—resin adhesive—that will change the thinking of entire envelope industry . . ." (RA. 17).

In and after said 1954 Stein Hall and other adhesive suppliers adopted and registered certain trade-marks as "Superseal", "Enva-Lok", "Res-N-Seal", and others for their respective imitations of PHANTOM-SEAL, and distributed many circulars among the envelope manufacturers, describing their respective product as having properties which had been long published as being the properties of PHANTOM-SEAL (RA. 50-51). Some of the statements issued by them show what they thought of defendant's invention.

"... and conservatively speaking is the first basic revolutionary improvement in front gums in 50 years, probably more, as I can't find anyone who remembers making envelope with anything but dextrin gums." (National Adhesives—May 25, 1954—(s) Ben C. Gorden). (RA. 50)

"Here is a seal gum that has all the attributes and advantages that you have always wanted." (Paisley Products, Inc. June 30, 1954—E.C. Lenz). (RA. 50)

Stein Hall sent a circular to envelope manufacturers, dated or postmarked Nov. 16, 1954, with samples of envelopes, with printing thereon, reading in part as follows: "FRONTSEAL MADE WITH 'SUPERSEAL' THE PERFECTED RESIN GUM". Another large adhesive supplier wrote, on February 14, 1955 (some two years after PHANTOM-SEAL was placed in the market) in a form letter to envelope manufacturers, as follows:

"As you undoubtedly know, a tremendous amount of researching has been undertaken in perfecting these resin remoistenable products over the last few months. As each improvement came up, we discarded the then current series and now I think we have something very superior to our initial efforts in developing these products."

These and other letters like them make it clear that when the accused infringers saw, spied on, and examined the defendant's device and knew that it could be done, thereafter it was a matter of trial and error before they could obtain a workable product. The fact that "tremendous amount of researching" had to be done in 1954 and 1955 furnishes a conclusive evidence that defendant's invention

was not an obvious step in 1952. As a matter of fact, being without the benefit of defendant's patent (applied for but not issued then), their "initial efforts" resulted in all but sheer disaster. Nor the accused infringers settled on the quality of their product until they had seen and studied defendant's patent.

Plaintiffs contend in effect that they do not infringe because they do not boil, they "cook". Plaintiffs' Exhibit 35 ("Products Formulation Sheet—Liquid—Stein Hall") contains the following directions: "Cook water, Elvanol . . . for one hour . . . Use: Envelope Seal gum—Old Colony" (R. 47). "Webster's New International Dictionary of the English Language", published by G. & C. Merriam Company, Springfield, 1922 contains the following definition of "cook"ing. "cook, v.t. . . . To prepare (food) by boiling . . . ; hence to prepare or treat (anything) by the action of heat." The same dictionary contains the following definition of "boil"ing: "boil, v.t. . . . 3. To subject to the action of heat in a boiling liquid, so as to produce some specific effect, as cooking or cleansing; . . ." (R. 47).

The District Court has granted summary judgment to plaintiffs because there "is no genuine issue as to any material fact", that defendant has not offered any affidavit of "observed facts", and that his affidavit is nothing more than "sworn arguments".

Defendant's affidavit (R. 25-35) begins (R. 26), as follows: "Defendant says on information and belief and/or on *personal knowledge*, that . . .". (Emphasis added). On the next page of said affidavit (R. 27) and on the one following he gives a table of "Vapor Pressure of Water" from an authentic publication based on "observed facts" on the

part of the author. On the two pages following (R. 29-30) he quotes from another authentic publication setting forth as observed facts as to what really is the "scientific definition of boiling". Further down on the same page (R. 30), defendant states:

> "Defendant was present at the 'Stein Hall' depositions on March 19, 1959, and parts of the following statement are based on the corrected transcript thereof, and parts *upon his observations as he remembers them.*" (Emphasis added).

The rest of said affidavit (R. 30-33) contains defendant's (your petitioner herein) personal observations during the deposition of John Mahlmann (R. 91-99), and the citation of an authentic publication (R. 32) upon the temperature of saturated steam at 50 pounds pressure. The jurat of said affidavit (R. 33) reads as follows:

> "Now came Setrak K. Boyajian, and said that *facts above stated of his own knowledge are true*, . . ." (Emphasis added).

Thus defendant (your petitioner herein) has stated observed facts in his affidavit (R. 25-33), and has quoted from scientific data of observed facts from authentic publications in corroboration of his statements under oath. He has further stated under oath that he is ready to prove such facts at the trial. The District Court argues that defendant should have engaged "scientific experts" to corroborate his sworn statements, unmindful of the fact that authors of scientific books such as defendant has quoted from are scientific experts and their work is based on their own experiments, and the value of their work is far the greater because they are not hired witnesses, and evidence

submitted in the form scientific publications is far more cogent than any affidavit.

Defendant's said affidavit (R. 25-33) was filed on August 25, 1960 (R. 2). Affidavit of John Mahlmann (R. 42-43) was not filed until November 1, 1962. Neither in that affidavit nor in any other pleadings plaintiffs have offered any sworn contradiction of defendant's observed facts as to the relation between temperature and vapor pressure in a boiling operation. Defendant has asserted under oath as an observed fact that during deposition of John Mahlmann (R. 91-99) the batch was boiling (as it is contemplated in the patent) at 190-200 F. by virtue of the reduced pressure above the batch. Plaintiffs argue that "the District Court refused to give credence to defendant's affidavit". Nor is the affidavit of John Mahlmann (R. 42-43) that "I can, and do, say categorically that no polyvinyl alcohol ingredient . . . was ever boiled" any valid contradiction of said sworn assertions be defendant. Mahlmann's affidavit states a belief on the part of its maker, regardless of how positive such belief may be. Your petitioner respectfully submits that an observed fact stated under oath does not require any qualification by the word "categorically" for it is simply stated according to what one or more of the five human senses have experienced in the subject matter, while the word "categorically" denotes a *strong belief*, and nothing more.

REASONS FOR GRANTING THE WRIT

1. The Court of Appeal's decision by giving its sanction to the District Court's reading the boiling-limitation into Claim 1 is directly in conflict with the applicable decision of this Court in *Deering v. Winona Harvester Works*, 155 U.S.

286, at 297-298, 302, wherein Mr. Justice Brown, delivering the opinion of the Court, said:

"The defences to these claims are:

"1. That claim 20 is void, in that it describes an incomplete and inoperative invention, and if completed by reading into it the necessary specifications, the defendants do not infringe.

"Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise element described in the patent as rendering it operative must be read into the claim. If Stewart were in fact the first to invent the pivotal extension to a butt-adjuster, he is entitled to a patent therefor, though the infringer may make use of other means than those employed by him to operate it. *Loom Company v. Higgins*, 105 U.S. 580-584. In such case any appropriate means for making it operative will be understood. Otherwise the infringer might take the most important part of a new invention, and by changing the method of adapting it to the machine to which it is an improvement, avoid the charge of infringement. The invention of a needle with the eye near the point is the basis of all sewing machines used; but the method of operating such a needle are many; and if Howe had been obliged to make his own method as part of every claim in which the needle was an element, his patent would have been practically worthless. We think it sufficiently appears that Stewart was the inventor of the pivotal extension described in the 20th claim, and that claim is valid, and was infringed by defendants."

While the foregoing decision is from an early case, the decision itself is of current vitality and was applied to the more recent case of *Doble Engineering Co. v. Leeds & Northrup Co.*, 434 F.2d 78, at 85 by the Court of Appeals for the First Circuit, the very court of appeals a review of whose decision your petitioner herein seeks, and which Court of Appeals has, because of an error or oversight, failed to apply the prior Supreme Court decision to this case; or (and which appears the more likely) the said Court of Appeals, has, for reasons of its own, deliberately refused to follow the said applicable Supreme Court decision. In either case, this Court may find that a summary reversal in this case is indicated.

Said earlier Supreme Court decision in the *Digring* case (supra) was also applied in principle to a more recent (1960) case in *Charles F. Hanson v. Ottis M. Colliver and Floyd E. Fuller*, 282 F.2d 66, C. A., Ninth Circuit, wherein it was held (on page 69) that it is the

> "well established rule of construction that a broad claim will not be construed to contain limitations expressed in more narrow claims. *Smith v. Snow*, 1935, 294 U.S. 1, 55 S.Ct. 279, 79 L. Ed.721; *Stearns v. Tinker and Rasor*, 9 Cir., 1957, 242 F.2d 17; *Great Lakes Equipment Co. v. Fluid Systems, Inc.*, 6 Cir., 1954, 217 F.2d 613.
>
> * * *
>
> "The doctrine (of equivalents) is applicable if the accused device performs substantially the same function in substantially the same way to obtain the same results as claimed for the patented device. *Sanitary Refrigerator v. Winters*, 1929, 280 U.S. 30, 42, 50 S.Ct. 9, 73 L.Ed. 147; *Graver Tank & Mfg. Co. v. Linde Air*

Products Co., 1950, 339 U.S. 605, 78 S.Ct. 854, 94 L.Ed. 1097.

"'A claim * * * does not limit a patentee to the exact mechanism described, leaving the public at liberty to construct substantially identical copies of the patented machine by varying the form or proportions (*White v. Dunbar*, 119 U.S. 47, 7 S.Ct. 72, 30 L.Ed. 303), or to adopt mechanical equivalents for the machine, or portions thereof. (*Hobbs v. Beach*, 180 U.S. 383, 21 S.Ct. 409, 45 L.Ed. 586)'

"Under the facts of this case and the law applicable thereto, the appellant is entitled to a decree that appellees' device infringes his patent * * *."

2. Thus, the Court of Appeal's decision in this case is also directly in conflict with the applicable decision of the Court of Appeals for the Ninth Circuit in the *Hauson* Case (supra) and cases cited therein; and since one of the prime purposes of the certiorari jurisdiction is to bring about uniformity of decisions among federal courts of appeals, such conflict remains an important basis for review. (*Harper & Leibowitz*, 102 U. of Pa. L.Rev. 427, 445—1954).

3. Thus, also, the Court of Appeal's decision in this case is directly in conflict with its own applicable decision in said *Doble* case (supra). The Court of Appeal's said decision in this case is, furthermore, hopelessly irreconcilable with its own earlier decision therein as relates to *additional obstacle*, the *lack of information in "Elranol"*, and *spelling out the purpose of a treatment* (R. 18, 20), as well as others of like nature. The record of this case (R), (RA), (RH) reveals the fact that a shockingly wrong decision on important issues has capriciously been made and your petitioner

prays that the same may be reviewed by this Court to resolve the intra-circuit inconsistencies in decisions therein, which fact may supply justification for summary reversal.

4. The Court of Appeal's decision in this case by giving its sanction to the District Court's granting summary judgment declaring claims in the patent in suit not infringed because plaintiffs have laid a complete foundation for their motion, because they have "deliberately" kept the temperature "several" degrees below 212, and because the temperature never reached 212, is directly in conflict with the applicable decision of this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 609, at 607-609 (1950), as relates to the Doctrine of Equivalents and the test of infringement, wherein Mr. Justice Jackson, delivering the opinion of the Court, said: (R. 13-14)

> "But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. * * * .
>
> "The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that *one may not practice a fraud on a patent.* (emphasis added). * * * 'To temper unsparing logic and prevent infringer from stealing the benefit of an invention' (L. Hand in *Royal Typewriter Co. v. Remington Rand*, 168 F.2d 691, 692) a patentee may invoke this doctrine to proceed against the producer of a device 'if it per-

forms substantially the same function in substantially the same way to obtain the same result.' *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42. * * * In its early development, the doctrine was usually applied in cases involving devices where there was equivalence in mechanical components. Subsequently, however, the same principles were also applied to compositions, where there was equivalence between chemical ingredients. Today the doctrine is applied to mechanical or chemical equivalents in compositions or devices."

5. The Court of Appeal's decision in this case is also in direct conflict with the applicable decision of this Court in *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 45.

Your petitioner was the first to understand and remedy the problem solved in the patent. The situation here is closely analogous to the situation which was before the Supreme Court in the *Eibel* case (supra). Here, as there, an essential part of the invention was the understanding of the problem which persisted the art. In the *Eibel* case, it was the discovery that the unequal speeds of stock and wire produced the defective paper product under high machine speed because of the disturbance and ripples some ten feet from the discharge. Here, it was the discovery that envelope seal gum comprising polyvinyl alcohol would become non-remoistenable during the shelf-life of the envelopes due to the contaminants which frequent in polyvinyl alcohol during the polymerization and saponification processes. Your petitioner used the expedient of boiling to solve the problem as the best means known to him for carrying out his invention at the time it was reduced to practice. Here, as in the *Eibel* case, it was not the mere use of a known technique to remedy a known source of trouble, but was, as

stated by Chief Justice Taft, "the discovery of the source not before known and the application of the remedy". (See also *In re Warren C. Conover*, 304 F.2d 680—CCPA, July 18, 1962).

6. The Court of Appeal's decision in this case is also in direct conflict with this Court's applicable decision in *Tilghman v. Proctor*, 102 U.S. 707, 732 733, wherein Mr. Justice Bradley said:

> "Finally, defendants argue that they only use a low degree of heat and pressure compared with that pointed out by the patent, * * *. The precise degree of heat, * * * is not of the essence of the patent. * * * What can be done in minutes by the application of a very high degree of heat, requires hours to do at the temperature used by the defendant. But the process remains the same."

7. The Court of Appeal's decision in this case is further in direct conflict with the applicable decision of the Court of Appeals for the Second Circuit in *Proctor & Gamble Co. v. Berlin Mills Co.*, 256 F. 23, 29, wherein it was held that a product patent is infringed if the product complained of is the patented article substantially as described; it making no difference by what path or process, new or old, inferior or improved, the infringing product is manufactured. This decision was rendered in 1919 but is of current vitality.

8. The decision of the District in this case, with the Court of appeals blanket sanction thereof, is directly in conflict with the applicable decisions of the majority of other federal courts, both district and appellate, as relates to summary judgment procedure. The following decisions are typical in this respect:

The function of affidavits upon a motion for summary judgment is to show what the parties can prove at the trial. (*Rosenblum v. Dingfelder*, 111 F.2d 406). On such motion affidavits may be considered for very limited purpose of determining whether an issue of fact exists, but cannot be used as a basis to decide a contested issue. (*Minnesota Mining & Mfg. Co. v. Pigmouth Rubber Co.*, 178 F.Supp. 591). The requirements of the rule relating to summary judgment are met by statement in jurat to effect that affidavits were made on personal knowledge (R. 26, 33) (*Puente v. President and Fellows of Harvard College*, 149 F.Supp. 33—DC Mass. 1957) (See also 248 F.2d 799). Affidavits may not be used as basis for deciding fact issues, upon motion for summary judgment, but they may be considered for purpose of ascertaining whether an issue of fact is presented. (*Pollack v. City of Newark*, 147 F.Supp. 85, affirmed in 248 F.2d 543—see also 355 U.S. 964). A summary judgment cannot be granted on basis of affidavits in the face of denial in pleadings. (*Bunny Bear, Inc. v. Dennis Mitchell Industries*, 139 F.Supp. 542). Nor can an affidavit be treated, for purpose of motion for summary judgment, as proof contradicting well pleaded facts in pleadings. (*Seaboard Serv. Co. v. Permacrete Const. Corp.*, 105 F.Supp. 349). In a proper case a motion for summary judgment may be granted in a patent infringement suit, but such motions have been generally denied when based solely on affidavits. (*Ollarch v. Goodyear Fabrics Corp.*, 30 F.Supp. 265). Summary judgment cannot be granted upon strength of plaintiffs' affidavit alone, and trial by affidavits of a disputed issue is not permitted. (*Weston v. Noble*, 19 F.R.D. 416). Courts have no power to pass on factual correctness of moving affidavits and evaluate their legal effect on motion for summary judgment. (*Powell v. Faber Brush Co.*, 15 F.R.D. 239). The rule regarding summary judgments

does not compel a party to try his case on affidavits with no opportunity to cross-examine affiants. (*U.S. v. Newbury Mfg. Co.*, 1 F.R.D. 718—DC. Mass., 1941). Even the opponent's failure (which is not the case here) to file counter-affidavit in answer to affidavit filed in support of motion for summary judgment does not compel the acceptance of facts alleged in movant's affidavit. (*Subin v. Goldsmith*, 224 F.2d 75). Courts are critical of papers presented by party moving for summary judgment, but not of the opposing papers. (*William v. Glacalone*, 154 F.2d 20). The case is viewed in light most favorable to party opposing summary judgment, and all doubts are resolved in his favor. (*Kimble v. Anderson-Tully Co.*, 16 F.R.D. 522). On motion for summary judgment, any doubt as to the existence of genuine issues of material fact is to be resolved against the movant. (*Krieger v. Ownership Corp.*, 270 F.2d 265).

9. While a measure of unanimity among the majority of federal courts on the foregoing issues in summary judgment procedure exists, this Court has not, but ought to have, laid down a uniform standard for the guidance of the lower courts in deciding such issues, and today a great deal of confusion in the case law as to the showing required to defeat a motion for summary judgment exists due to the conflicting views among various lower courts as to the utility and application of this procedural device.

10. Questions herein presented remain one of substantial importance in the administration of patent law, as well as summary judgment procedure, not just to this case but to all applicable cases, such importance being "beyond the academic or the episodic." (*Rice v. Sioux City Cemetery*, 349 U.S. 70, 74), and residing in the public interest as distinguished from that of particular parties involved.

11. In this case the decision below is shockingly wrong and presents substantial due process questions, and evidence presented therein was sufficient to support a jury verdict for defendant, and, therefore, such decision granting summary judgment to plaintiffs deprived defendant of his right to a jury decision. (Appendix H).

12. The decision below in this case represents a gross miscarriage of civil justice, as well as a subtle erosion of statutory or legal principle, and the result reached therein is unduly harsh in its impact, and ought to be reviewed by this Court. Cf. *Montana v. Kennedy*, [illegible] U.S. 308.

13. Patent in suit in this case is of unusual public importance, and the Court of Appeals failed to bring proper statutory and legal considerations to bear upon the issues of infringement of said patent, and the decision below involves questions of federal law that go beyond the ordinary issues of infringement of the particular patent.

14. Two other actions involving the same patent (2, 80a, 395); (RA. 97-101) are now pending in the United States District Courts within the Third and District of Columbia Circuits, and owing to the widespread character of the infringement of said patent, other such actions are bound to follow, and the repercussion of the decision below herein sought to be reviewed will be adversely felt on such other actions unless the writ herein prayed for is granted, which grant will also tend to avoid undue multiplicity of actions.

15. The Court of Appeals has in this case so far departed from the accepted and usual course of judicial proceedings by sanctioning such departure by the District Court, as to call for an exercise of this Court's power of supervision. The District Court's premature [illegible]

consists of statements, paraphrased on plaintiffs' argument, which cannot be reconciled with the record.

16. The Court of Appeals has in this case decided an important question of federal law, as appears from the record, which has not been, but should be, settled by this Court.

CONCLUSION

For reasons above stated, your petitioner prays that the writ of certiorari herein sought may be granted.

Respectfully submitted,

SETRAK K. BOYAJIAN, *Petitioner*

P. O. Box 973

Worcester 1, Massachusetts

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 6120

SETRAK K. BOYAJIAN, ETC.,
Defendant, Appellant,

v.

OLD COLONY ENVELOPE CO., INC., ET AL.,
Plaintiffs, Appellees.

JUDGMENT

November 5, 1963

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by appellant, *pro se*, and by counsel for appellees.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The amended judgment of the District Court is affirmed.

By the Court:

s/ ROGER A. STINCHFIELD,
Clerk.

APPENDIX B

UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

No. 6120.

SETRAK K. BOYAJIAN, ETC.,

DEFENDANT, APPELLANT,

v.

OLD COLONY ENVELOPE CO., INC., ET AL.,

PLAINTIFFS, APPELLEES.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MASSACHUSETTS

Before WOODBURY, *Chief Judge*, and HARTIGAN and ALDRICH, *Circuit Judges*.

Setrak K. Boyajian pro se.

Elsie M. Graves, with whom Richard G. Fuller, Jr., Donald R. Grant, Brumbaugh, Free, Graves & Donohue and Ropes & Gray were on brief, for appellees.

OPINION OF THE COURT.

November 5, 1963.

PER CURIAM. Judgment will be entered affirming the amended judgment below entered February 6, 1963 for the reasons given by Judge Wyzanski in his memorandum dated February 5, 1963.*

* For the result of prior litigation between the parties, see Old Colony Envelope Company v. Boyajian, 176 F.Supp. 627 and Boyajian v. Old Colony Envelope Company, 279 F.2d 572.

APPENDIX C

UNITED STATES COURT OF APPEALS

FOR THE FIRST CIRCUIT

No. 6120.

SETRAK K. BOYAJIAN, ETC.,

Defendant, Appellant,

v.

OLD COLONY ENVELOPE CO., INC., ET AL.,

Plaintiffs, Appellees.

ORDER OF COURT

November 26, 1963.

It is ordered that the petition for rehearing, filed November 19, 1963, be, and the same hereby is, denied.

By the Court:

/s/ ROGER A. STINCHFIELD,

Clerk.

APPENDIX D

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 6129.

SETRAK K. BOYAJIAN, ETC.,
Defendant, Appellant,

v.

OLD COLONY ENVELOPE CO., INC., ET AL.,
Plaintiffs, Appellees.

ORDER OF COURT

November 26, 1963.

Upon consideration of appellees' bill of costs, the Clerk's proposed taxation of costs in the total amount of $2,524.95, appellant's opposition thereto, appellees' memorandum in support thereof, and statement by appellant in reply to appellees' memorandum,

It is ordered that costs be taxed in the amount of $2,524.95, as proposed by the Clerk.

By the Court:

/s/ ROGER A. STINCHFIELD,
Clerk.

APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 6120.

SETRAK K. BOYAJIAN, ETC.,
Defendant, Appellant,

v.

OLD COLONY ENVELOPE CO., INC., ET AL.,
Plaintiffs, Appellees.

ORDER OF COURT

December 4, 1963

Upon motion of appellant to stay mandate herein pending an application to the Supreme Court of the United States for a writ of certiorari, the same to be filed by January 2, 1964, and notice of such filing to be filed promptly with the Clerk of this Court, and without any memorandum in behalf of appellees,

It is ordered that said mandate be, and the same hereby is, stayed.

By the Court:

ROGER A. STINCHFIELD,
Clerk.

APPENDIX F

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 6120

SETRAK K. BOYAJIAN, ETC.,
Defendant, Appellant,

v.

OLD COLONY ENVELOPE CO., INC., ET AL.,
Plaintiffs, Appellees.

ORDER OF COURT

December 16, 1963.

Upon motion of appellant,

It is ordered that the order of this Court of December 4, 1963, be, and the same hereby is, amended by substituting "January 31, 1964" for "January 2, 1964" as the time by which application for a writ of certiorari is to be filed.

By the Court:

/s/ ROGER A. STINCHFIELD,
Clerk.

APPENDIX G

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 6120.

SETRAK K. BOYAJIAN, ETC.,
Defendant, Appellant,

v.

OLD COLONY ENVELOPE CO., INC., ET AL.,
Plaintiffs, Appellees.

ORDER OF COURT

January 7, 1964.

Upon motion of appellant,

It is ordered that the order of this Court of December 4, 1963, be, and the same hereby is, amended by substituting "February 20, 1964" as the time by which application for a writ of certiorari is to be filed.

By the Court:

ROGER A. STINCHFIELD,
Clerk.

APPENDIX H

Excerpt from Page 31, Transcript of hearing in the District Court on September 14, 1959, in Old Colony v. Boyajian 57-1246-W.

* * *

Mr. BOYAJIAN. I submit, your Honor, there are so many issues of fact in this case that I think it is not a matter for summary judgment, and I wish, your Honor, that you would deny the motion and have a pre-trial hearing to narrow down the issues and have a jury case made out because that is the only way to handle it. Thank you.

The COURT. Have you in any sense waived a jury?

Mr. BOYAJIAN. No, I didn't say that. I haven't waived a jury. * * * *

The COURT. I don't understand what you mean by all that. It isn't usual to claim a jury in a patent case. If indeed you claim one. I think this is the first time in 18 years I have had a case in which anybody claimed a jury in a patent matter.